

REMARKS

This is a full and timely response to the non-final Official Action mailed December 29, 2008 (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Under a previous Restriction Requirement, claims 12, 13, 25, 26, 45 and 46 have been withdrawn from consideration. (Action, p. 3). However, the withdrawal of these claims is clearly improper. The Action states that claims 12, 13, 25, 26, 45 and 46 are “Generic to Species I and II.” (Action, p. 3). Because Applicant elected Species I, Applicant is entitled to examination of any claims that are generic to the elected species, i.e., claims 12, 13, 25, 26, 45 and 46. Therefore, the withdrawn claims should be rejoined and examined in the next Office Action.

By the forgoing amendment, various claims have been amended. Additionally, claim 38 has been cancelled without prejudice or disclaimer. No new claims are added.

Thus, claims 1-11, 14-24, 27-37, 39-44, 47 and 48 are currently pending for further action.

Allowable Subject Matter:

In the outstanding Office Action, the Examiner indicated the presence of allowable subject matter in claims 9-11, 22-24, 38 and 42-44. Applicant wishes to thank the Examiner for this identification of allowable subject matter. Applicant agrees with the Examiner's conclusions regarding the patentability of these claims, without necessarily agreeing with or acquiescing in the Examiner's reasoning, whether explicit or implied.

In response to this indication of allowable subject matter, Applicant has taken the following actions.

- (1) Claim 1 has been amended to include most of the subject matter of allowable claim 9.
- (2) Allowable claim 22 has been amended and rewritten as an independent claim. Former independent claim 14 has been amended to depend from claim 22.
- (3) Claim 32 has been amended to include all the language of allowable claim 38, and claim 38 has been cancelled.
- (4) Claim 39 has been amended to include most of the subject matter of allowable claim 42.
- (5) Formerly independent claim 47 has been amended to depend from claim 39.

Consequently, following entry of this amendment, each of claims 1, 22, 32 and 39, along with their respective dependent claims, should be in condition for allowance based on the allowable subject matter identified in the recent Office Action. Notice to this effect is respectfully requested.

Objection to Drawings:

The outstanding Office Action objected to the drawings as not showing every feature of the invention specified in the claims. According to the Action, the drawings don't show the step of "comparing said date information with said current date when a print cartridge is installed." (Action, p. 3). Applicant respectfully disagrees. This idea of comparing the dates when a new print cartridge is installed is illustrated in, for example, Fig. 4, elements 136 and 131-33). With reference to Fig. 4, Applicant's specification states that "the printing device determines (at step 136) when a current print cartridge is removed and a new (or possibly the

same) print cartridge is installed.” (Applicant’s specification, paragraph 0035).

Consequently, the objection to the drawings should be reconsidered and withdrawn.

Objection to Claims:

The outstanding Office Action objected to a number of claims for alleged informalities. With respect to claims 27 and 47, the Action helpfully points out that the term “population of monitored printing devices” should be plural. Accordingly, Applicant has amended the claims as suggested by the Office Action in this respect. This amendment does not, and is not intended to, change or narrow the scope of the claims in any degrees.

All of the other objections to the claims indicate a preference for use of the article “said.” However, Applicant respectfully disagrees that “said” is required in any of the instances noted in the Action.

Moreover, Applicant notes that, according to the MPEP, “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” MPEP § 2173.02. The claims indicated are phrased as Applicant desires to recite what Applicant believes to be patentable subject matter. Therefore, any remaining objections to the claims should be reconsidered and withdrawn.

35 U.S.C. § 112, second paragraph:

In the recent Office Action, claims 2, 27 and 47 were rejected under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner’s comments.

While Applicant does not necessarily agree that any of these claims were indefinite as filed, the indicated claims have been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, second paragraph. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Prior Art:

(1) Claims 1, 2, 4-8, 14-16, 18-21, 27, 29-32, 35-37, 39-41 and 47 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,625,402 to Takemoto (“Takemoto”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1:

A system for detecting potential counterfeiting of print cartridges comprising at least one printing device programmed to:
read date information from an installed print cartridge,
read a current date from a clock in said printing device,
and
compare said date information and said current date to determine if a difference between said date information and current date exceeds a threshold.

Support for the amendment to claim 1 can be found in Applicant’s originally filed specification at, for example, claim 9 which the recent Office Action held allowable.

Accordingly, as recognized in the recent Office Action, Takemoto does not teach or suggest a “printing device programmed to: read date information from an installed print cartridge, read a current date from a clock in said printing device, and compare said date information and said current date to determine if a difference between said date information and current date exceeds a threshold.” This subject matter is entirely outside the scope and content of the cited prior art.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Takemoto of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 22:

Claim 22 recites:

A method for detecting potential counterfeiting of print cartridges, said method comprising:

- reading data information from a print cartridge in a printing device;
- reading a current date from a clock
- comparing said date information and said current date to determine if a difference between said current date and said date information exceeds a predetermined threshold indicating a potentially counterfeit print cartridge.

As indicated above, claim 22 has already been held allowable by the current Office Action. Consequently, claims 14-21 and 23-26 which now depend from claim 22 should also be held clearly allowable.

Claim 27:

Claim 27 recites:

A system for detecting potential counterfeiting of print cartridges comprising a monitoring server programmed to:

- receive messages from a population of monitored printing devices, wherein each said message includes date information from a print cartridge installed in a monitored printing device, and

- analyze messages from monitored printing devices for patterns indicative of counterfeiting of print cartridges.

In contrast, Takemoto clearly does not teach or suggest analyzing multiple messages from a number of monitored printing device for patterns indicative of counterfeiting of print cartridges.

In this regard, the Office Action cites to Takemoto at col. 5, lines 20-30. (Action, p. 8). This portion of Takemoto states the following.

The information service server 2 includes a genuine product identifying section 23 for determining whether or not the image forming cartridge 6 is a genuine product based on the received identification information 62a of the image forming cartridge 6, and a distribution controller 21 for distributing an optimal image forming condition 62b, which is conformable to the identification information 62a of the image forming cartridge 6, based on an image forming condition table 24c stored in the storage 24 when the image forming cartridge 6 is determined as an genuine product by the genuine product identifying section 23.
(Takemoto, col. 5, lines 20-30).

Thus, Takemoto teaches receiving identification information, i.e., a manufacturer's serial number (Takemoto, col. 3, line 58), comparing that information to a table (24c) of such serial numbers to determine if a particular cartridge is genuine. Clearly, this does not teach or suggest the claimed method in which a monitoring server is analyzing a plurality of messages from a plurality of monitored printing devices to find, not just the authenticity of a particular cartridge, but "patterns indicative of counterfeiting of print cartridges." (Claim 27).

Whereas Takemoto merely determines the authenticity of a particular cartridges, claim 27 recites a system that identifies patterns indicative of the counterfeiting of multiple print cartridges. This subject matter is entirely outside the scope and content of Takemoto.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the

rejection based on Takemoto of claim 27 and its dependent claims should be reconsidered and withdrawn.

Claim 32:

Claim 32 recites:

A system for detecting potential counterfeiting of print cartridges comprising:
means for transmitting a message from a printing device regarding date information stored on a print cartridge installed in a printing device; and
means for receiving said message and analyzing said message and other messages to identify patterns indicative of counterfeiting of print cartridges;
said system further comprising;
means for reading a current date from a clock in said printing device,
means for comparing said date information and said current date, and
means for transmitting said message if a difference between said current date and said date information exceeds a predetermined threshold.

As indicated above, claim 32 was amended herein to include verbatim the recitations of allowable claim 38, which has been cancelled without prejudice or disclaimer.

Consequently, claim 32 and its remaining dependent claims are clearly patentable over the prior art of record as held by the recent Office Action. (Action, p. 12).

Claim 39:

Claim 39 recites:

Processor-readable instructions stored on a medium for storing processor-readable instructions, said instructions, when executed, causing a processor to:
read date information from a print cartridge installed in a printing device,
read a current date from a clock, and
compare said date information and said current date to determine if a difference between said current date and said date information exceeds a predetermined threshold indicative of expiration of an expected useful life of said print cartridge.

Support for the amendment to claim 39 can be found in Applicant's originally filed specification at, for example, claim 42 which the recent Office Action held allowable.

Accordingly, as recognized in the recent Office Action, Takemoto does not teach or suggest a instructions that cause a processor to "read date information from a print cartridge installed in a printing device, read a current date from a clock, and compare said date information and said current date to determine if a difference between said current date and said date information exceeds a predetermined threshold indicative of expiration of an expected useful life of said print cartridge." This subject matter is entirely outside the scope and content of the cited prior art.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Takemoto of claim 39 and its dependent claims should be reconsidered and withdrawn.

(2) Claims 3, 17, 28, 34 and 48 were rejected under 35 U.S.C. §103(a) over the combined teachings of Takemoto and U.S. Patent App. Pub. No. 2002/0188860 to Parry. This rejection should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of the corresponding independent claims.

(3) Claims 4, 5, 18, 19, 29, 30, 35, 36, 40 and 41 were rejected under 35 U.S.C. §103(a) over the teachings of Takemoto taken alone. This rejection should be reconsidered and

withdrawn for at least the same reasons given above in favor of the patentability of the corresponding independent claims.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner may seek to rely on Official Notice, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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